

REMARKS

It is noted that the Office Action Summary (PTOL-326) indicates under § 12 that a claim for foreign priority has been acknowledged. However, it is not quite correct that a priority under 35 U.S.C. §119 has been claimed. Rather, a claim for priority has been made under 35 U.S.C. §120 as indicated on page 1 of the present specification in the section captioned "Cross-reference to related application" and as correctly indicated on the Official Filing Receipt mailed February 5, 2002. Moreover, a certified copy of the priority document i.e. PCT/EP99/04847 was filed in the USPTO on May 20, 2002. Inasmuch as the PCT application was in the English language, it is believed that the claim of priority has been perfected and no further action is required on the part of applicant. If this is incorrect, please advise.

Regarding the 35 U.S.C. §102(e) rejection of 1-10 as being anticipated by Alperovich et al. (U.S. 6,101,393), Alperovich et al. has been reviewed carefully and it is believed that it represents the prior art as described in the present specification under the background of the invention section where it is made clear that although the prior art provides a method to restrict incoming messages from a point of view of a mobile terminating terminal, the prior art does not provide a method for the mobile originated case. This would be useful for instance for the case where the user of the terminal for the purposes of short messaging services are children and young people where the parents, who pay the telephone bills, wish to restrict the short message service or for the case where blocking the sending of SMS messages originating from a terminal would be desirable for some other reason including reasons of the operator of a network where for example roaming subscribers whose home operator does not have a charging agreement with a visiting subscriber.

The passages cited by the Examiner, i.e. column 2, lines 5-22 and column 4, lines 30-46, as well as column 4, line 48 to column 5, line 3, clearly show that a list (i.e. record) containing information about certain addresses with which a message communication is not allowed is stored in a home location register (at HLR) and that

a screening mechanism (i.e. decision step) is activated when the HLR is interrogated by the mobile services switching center (see column 2, lines 8-10). From that, it appears to be quite clear that both the "record" and the "decision" in the sense of the present invention are located at the home location register and not in a mobile services switching center, as claimed in both independent claims.

Thus, the Alperovich et al. disclosure must be understood as being restricted to a screening mechanism for selectively accepting and rejecting wanted and unwanted short message service messages that are incoming to a mobile terminating terminal. There is no mention whatsoever in the Alperovich et al. disclosure of the subject matter of the present invention in which the decision step and the preventing step is done in a switching center (see Fig. 1, 11, 15) and the record (28) is kept in the switching center (11, 15). Fig. 3 of the Alperovich et al. disclosure clearly shows the screening mechanism 200 in the HLR 26 and not the switching center. Fig. 2 of Alperovich et al. makes it clear that the message coming from originating mobile station A and traversing the network 30, 35, 40, 50 is first checked in the HLR 26 by means of the screening mechanism 200 in order to determine whether the target mobile station 22 wants to receive such a message or not. Fig. 6 of Alperovich et al. shows how the mobile terminating station 20 can inform the HLR 26 of its preferences in this regard for use by the screening mechanism 200. Thus, the Alperovich et al. reference is strictly confined to blocking using delivery-selection criteria and has nothing to do with the presently claimed invention which makes it possible to prevent the transmission of a message.

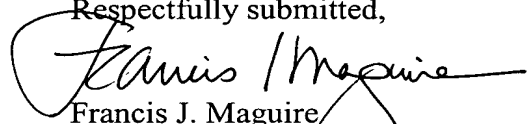
Already in the International Preliminary Examination Report which has issued in the international proceedings of the present case, the European Patent Office has discussed in detail that the present invention is an advance over the prior art and considered the claims to have both novelty and inventive step under the provisions of Article 35. See the enclosed International Preliminary Examination Report which has a discussion touching on the above-mentioned considerations. Although the IPER does not specifically address the reference cited by the U.S. Examiner, the considerations are generally the same and applicant believes that the

USPTO should also come to the same favorable conclusion regarding the pending claims 1-10.

Withdrawal of the 35 U.S.C. §102(e) rejection of claims 1-10 as being anticipated by Alperovich et al. is requested.

The objections and rejections of the Office Action of November 18, 2004, having been obviated by amendment or shown to be inapplicable, withdrawal thereof is requested and passage of claims 1-10 to issue is solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Francis J. Maguire", written over the printed name.

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